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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,426	02/25/2002	David J. Barton	L-13173	6740

7590                    08/14/2003

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[REDACTED] EXAMINER

PICKETT, JOHN G

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

3728

DATE MAILED: 08/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/083,426	BARTON, DAVID J.	
	Examiner Greg Pickett	Art Unit 3728	
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			
<b>Period for Reply</b>			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.			
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>25 February 2002</u> .			
2a) <input type="checkbox"/> This action is <b>FINAL</b> .                    2b) <input checked="" type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
<b>Disposition of Claims</b>			
4) <input checked="" type="checkbox"/> Claim(s) <u>1-47</u> is/are pending in the application.			
4a) Of the above claim(s) <u>33-38, 46 and 47</u> is/are withdrawn from consideration.			
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.			
6) <input checked="" type="checkbox"/> Claim(s) <u>1,2,30-32 and 40-45</u> is/are rejected.			
7) <input checked="" type="checkbox"/> Claim(s) <u>3-29 and 39</u> is/are objected to.			
8) <input checked="" type="checkbox"/> Claim(s) <u>33-38, 46 and 47</u> are subject to restriction and/or election requirement.			
<b>Application Papers</b>			
9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner.			
10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>25 February 2002</u> is/are: a) <input checked="" type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).			
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.			
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.			
<b>Priority under 35 U.S.C. §§ 119 and 120</b>			
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1.) <input type="checkbox"/> Certified copies of the priority documents have been received. 2.) <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3.) <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.			
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.			
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.			
<b>Attachment(s)</b>			
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .	
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)	
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 		6) <input type="checkbox"/> Other: _____ .	

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species 1, figures 1-9, Species 2, Figures 10-11.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 40 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Robert Vickers on July 22, 2003 a provisional election was made without traverse to prosecute the invention of Species 1, claims 1-30, and 39-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 33-38 and 46-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

3. The abstract of the disclosure is objected to because the word "along" in the last sentence appears to be a typographical error. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

4. Claim 39 is objected to because of the following informalities: the phrase, "juxtaposed the top" recited in line 6 is grammatically incorrect. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 40-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "cooperable" in claim 40 is a relative term which renders the claim indefinite. The term "cooperable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The interaction between the first ring and the second ring is indeterminate. Further, the minimum number of rings required by the claim is indeterminate.

Claims 41-45 are dependent on claim 40 and are rejected for the above reason.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagata (JP 58183570 A).

Nagata discloses a payout (Figure 6) for controlling the payout of wire (3) from a coil of wire in a drum (1) having a drum axis, a drum body (1), and a core (2), wherein

the payout comprises a first ring (41B), a second ring (41A), and a circular gap (51).

The payout of Nagata is arranged and functions as claimed by the applicant.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2, 30-32, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata in view of Smith et al (GB 2 332 451).

Regarding claim 2, Nagata discloses a payout as applied to claim 1 above. Nagata does not disclose a third ring overlaying the first and second rings.

Smith et al discloses a payout with a ring (2) disposed on the wire coil (6) for ensuring a smooth delivery of the wire. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to provide the payout of Nagata with a third ring as taught by Smith et al in order to provide for a smooth delivery of the wire.

As to claim 30, payout of Nagata-Smith discloses a first and second ring along with a gap that is coaxial with the drum axis (Nagata, Figure 6).

As to claims 31 and 32, the payout of Nagata-Smith discloses the claimed invention except for expressly disclosing the first, second, and third rings made of cardboard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the payout of Nagata-Smith with first, second, and third rings made of cardboard, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 40, the examiner interprets the claim as requiring three rings for operation. Nagata discloses a payout (Figure 6) for controlling the payout of wire (3) from a coil of wire in a drum (1) having a drum axis, a drum body (1), and a core (2), wherein the payout comprises a first ring (41A) laterally stationary with the drum axis, and another ring (41B). The payout of Nagata is arranged and functions as claimed by the applicant. Nagata meets all limitations claimed by the applicant except for the second ring.

Smith et al discloses a payout with a ring (2) disposed on the wire coil (6) for ensuring a smooth delivery of the wire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the payout of Nagata with a

third ring as taught by Smith et al in order to provide for a smooth delivery of the wire. As such, the rings of Nagata-Smith cooperate to payout the wire.

As to claim 41, the payout of Nagata-Smith discloses a second ring (Smith, 2) which overlies the first ring (Nagata 41A) and functions as claimed by the applicant.

As to claim 42, the payout of Nagata-Smith discloses a second ring (Smith, 2) the base of which is coplanar with the first ring (Nagata 41A).

***Allowable Subject Matter***

8. Claims 3-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 39 is objected to for minor informalities but would be allowable if rewritten in independent form to overcome the objection presented in this Office action.

10. Claims 43-45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sakai et al and Ohike et al disclose means to control the payout of welding wire.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

*GP*  
Gregory Pickett  
Examiner  
August 10, 2003

*Mickey Yu*  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700